

REMARKS

The Official Action mailed April 28, 2004, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, Applicant respectfully submits that this response is being timely filed.

Applicant notes with appreciation the consideration of the Information Disclosure Statement filed on January 22, 2004. However, the Applicants have not received acknowledgment of the Information Disclosure Statements filed on January 8, 2004 and March 10, 2004. Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of this Information Disclosure Statement.

Regarding the Information Disclosure Statement filed January 8, 2004, the Official Action asserts that "a preliminary review shows that the IDS contains references that are not material to patentability and are superfluous to the determination of patentability" and concludes that since "review of voluminous non-pertinent material places a burden on this Office, Applicant's IDS will therefore not be considered" (pages 4-5, Paper No. 0404, citing 37 CFR § 1.56, MPEP § 609, MPEP § 2004, ¶13, and, specifically, the *Penn Yan* case). The Applicants respectfully disagree and traverse the above-referenced assertions and decision.

37 CFR § 1.56 clearly states that the "duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98." The Applicants respectfully submit that all information known to be material to patentability of any claim in the present application has been submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. Furthermore, Rule 97 makes clear that the Patent office "shall" consider any IDS that is properly filed in accordance with that section. That is, consideration by the Office is mandatory, not optional. Applicant's are further unaware

of any rule that provides for non-consideration of an IDS based its size or materiality of the information, as asserted in the Official Action. The Applicants respectfully submit that the IDS filed January 8, 2004, fully complies with the rules and must be considered by the Examiner in a timely manner.

Furthermore, regarding the *Penn Yan* case, a patent was held unenforceable due to inequitable conduct resulting from the intentional burying of a highly material reference in a large IDS. Although *Penn Yan* notes in dicta that long lists of references should be avoided, the Applicants in no way intend to bury a highly material reference. The Applicants have identified the references cited in the IDS filed January 8, 2004, as possibly being material to the subject application. The Applicants are under an obligation to provide any information that may be material to patentability. In fact, as noted in MPEP § 2004, ¶10, **"When in doubt, it is desirable and safest to submit information. Even though the attorney, agent, or applicant doesn't consider it necessarily material, someone else may see it differently and embarrassing questions can be avoided"** (emphasis added). Furthermore, 37 CFR 1.97(h) makes clear that the filing of an IDS is not an admission (or representation) that the information contained therein is material to patentability and thus contemplates that non-material information may be submitted as suggested by the MPEP. It is not the Applicant's duty to insure that every reference submitted is material to patentability, but rather that any reference that may be material to patentability be submitted so that it may be fully considered by the Examiner. The cited references may be material to patentability and are appropriate for consideration by the Examiner. The obligation to consider the references is not optional, but mandatory by the Office and consideration is requested.

Claims 8-25 were pending in the present application prior to the above amendment. Claims 8-11, 13-15, 17, and 19-23 have been amended to better recite the features of the present invention and new claims 26-28 have been added to recite additional protection to which Applicant is entitled. Accordingly, claims 8-28 are now pending in the present application, of which claims 8, 9, 13-15, 19, and 20 are

independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 8, 9, 18, and 20 as obvious based on the combination of U.S. Patent No. 5,942,767 to Na. and U.S. Patent No. 5,668,379 to Ono. It is believed that the recitation of claim 18 is a typographical error and that the Official Action intended to include claims 8, 9 19, and 20 in the present rejection. It is noted that no other rejection of claim 19 is asserted.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 8, 9, 19, and 20 have been amended to replace "conductive film" with --metal film-- and now recite that a transparent conductive film is formed in contact with the metal film, which is etched in the sixth etching step. It is respectfully submitted that the prior art of record, taken

alone or in combination, fails to disclose or suggest at least this feature of the present invention. Even should one of ordinary skill in the art be motivated to combine Na and Ono, one would not obtain the claimed method because the top surface after etching the chromium silicide layer 451, the highly doped amorphous silicon layer 44 and the amorphous silicon layer 16 of Na is the chromium silicide layer 451 (not a metal layer; See FIG. 5D of Na). Therefore, reconsideration and withdrawal of the outstanding rejection is respectfully requested.

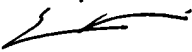
Paragraph 4 of the Official Action further rejects claims 10-12, 16-18, and 21-25 as obvious based on the combination of Na, Ono, and U.S. Patent No. 6,583,065 to Williams. Paragraph 6 of the Official Action also rejects claims 13-15 as obvious based on the combination of Na, Ono, and Williams.

It is respectfully submitted that Williams does nothing to overcome the deficiencies noted above with respect to Na and Ono. Independent claims 13-15 have been amended herewith to recite one of an aluminum and titanium film (claim 13), a tantalum film (claim 14), and a tungsten film (claim 15). As noted above, Na discloses a chromium silicide layer. Since the prior art of record fails to disclose or suggest the use of aluminum, titanium, tantalum, or tungsten as recited in claims 13-15 as amended herewith, it is respectfully submitted that a *Prima Facie* case of obviousness cannot be maintained and favorable reconsideration is requested.

New dependent claims 26-28 have been added reciting wet and dry etching treatments are contained in one etching step, which is disclosed on at least page 24 lines 11-14, of the subject specification. Favorable consideration of new claims 26-28 is respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789